PATENT
Attorney Docket No. 205654

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Kovesdi et al.

Application No. 09/832,355

Filed: April 10, 2001

For: VEGF FUSION PROTEINS

Art Unit: 1647

Examiner: Spector, L.

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

    In response to the Office Action dated June 11, 2002, please consider the following remarks.

REMARKS

    The Office has set forth an election of species requirement. Applicants elect, with traverse, the fusion protein wherein the second peptide portion is HBNF. Claims 1-7, 9-12, 14-19, 28-46 encompass the elected species. Applicants understand that at least these claims will be examined at the present time and that upon the allowance of a generic claim, dependent claims to additional species will be entitled to consideration. In any event, however, reconsideration of the election of species is respectfully requested.

    There are two separate criteria for a proper requirement for restriction between patentably distinct inventions: (i) the inventions must be independent or distinct as claimed, *and* (ii) there must be a serious burden on the Examiner if restriction is not required. Both of these criteria must exist for a restriction requirement to be proper, and "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." M.P.E.P. § 803.

    In the case at hand, the Office fails to meet the above-identified criteria and to present the required supporting evidence and reasoning. The Office has not even so much as alleged that there would be a serious burden on the Examiner if election of species were not required. The Office has not so much as demonstrated that the identified species are classified in different classes or subclasses. There is no indication in the Office Action that examination of the

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